

## **REMARKS**

Claims 1-14 and 24-26 are pending. Claims 1-26 have been cancelled. Claims 27-49 have been added. Applicants do not intend to create estoppel by cancelling claims 15-23, which were withdrawn in response to the restriction requirement set forth in the Office Action mailed February 22, 2005. Applicants reserve their right to file future divisional applications based on these claims.

### **35 U.S.C. §101 Rejections**

Claims 1-14 and 24-26 stand rejected under 35 U.S.C. §101 “because the claimed invention is directed to non-statutory subject matter.” Applicants believe that this rejection is moot because claims 1-14 and 24-26 have been cancelled. New claim 27 does not recite a “data exchange engine” or a “virtual record manager” as recited in claim 1. Instead, claim 27 recites “an engine” and “a database.” Because these elements recite software (i.e., the engine) acting in conjunction with a hardware component (i.e. the database), the information exchange system of claim 27 has the physical structure of a machine in terms of its hardware and software combination. MPEP §2106 II.C. Therefore, claims 27-34 are directed to statutory subject matter and are not subject to a 35 U.S.C. §101 rejection.

### **35 U.S.C. §102(e) Rejections**

Claims 1-11 and 24-26 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,735,591 to Khan (hereinafter “Khan”). As claims 1-11 and 24-26 have been cancelled, this 35 U.S.C. §102(e) rejection is moot. Applicants do not

acquiesce to the §102(e) rejection for claims 1-11 and 24-26 and do not intend to create estoppel by cancelling claims 1-11 and 24-26. Instead, Applicants have added claims 27-49 and would prefer to proceed with the new claims 27-49. New claims 27-49 contain limitations not anticipated by Khan.

Claim 27 recites an engine configured to determine whether to provide a selected field of the personal information of a second party to a first party. Khan teaches an information warehouse where “[a]ny type of data and relationship between the various data elements can be described as a combination of one or more of an element of information” (col. 1, lines 65-67 to col. 2, line 1). In the information warehouse, relationships between the data fields are stored using LinkIDs and Relatives\_Table\_IDs (Figures 7a, 7b, 7c-1, and 7c-2).

Khan teaches establishing relationships between data elements (col. 9, lines 52-53). For example, Table 3 discloses creating links between people for relationships such as family or business contacts (col. 10, lines 20-22). However, showing or establishing relationships between individuals in a database as in Khan does not teach or suggest “an engine configured to...determine whether a selected field of the personal information of a second party can be provided to the first party” based on an identification of the first party as recited in new claim 27. Applicants fail to see any teaching in Khan of field-level control of personal information of the second party that can be provided to the first party.

In addition, a “transaction” is defined in Khan as “the exchange of a relationship from one pair of data items to another” (col. 12, 35-37). To illustrate, there are

three data items, individuals A and B, and a material object Car. ... [T]he relationship ‘owns’ is used to indicate that A owns the car. ... A sells the car to B. The transactions table is used to keep track of changes in

relationships to an object, such as the car, and to store one or more values associated with the change in relationship, such as the price of the car

(col. 12, lines 37-44, Figures 8a and 8b). Exchanging a relationship from one pair of data items to another does not teach or suggest determining whether a selected field of personal information can be shared with a first party as recited in claim 27.

Field-level control of personal information of a party that can be shared with another party has at least two advantages. Claim 27 increases the security of a party's personal information by limiting which parties the personal information is provided to. Additionally, the ability to determine whether to provide sensitive personal information to a first party rather than a second party provides the ability for the party to control the dissemination of personal information for privacy reasons. For example, personal information such as credit card information can be shared with a bank but not with a friend. Alternatively, a determination can be made to provide a new home address to a friend but not to a business contact. This provides finer granularity of which fields of personal information are provided to other parties. Therefore, Khan's teaching of establishing relationships between data items does not teach or suggest determining whether to provide a selected field of personal information to another party as recited in claim 27.

Claim 27 also recites an engine configured to determine an identity of a first party to be provided personal information. An Individuals Table in Khan contains records for each individual stored in the directory (Figure 7a, Table 3, and col. 10, lines 13-14). In Khan, this table includes data about the individuals whose information is stored in the information warehouse. However, identifying individuals and their relationships with other individuals and information within the information warehouse of Khan does not

identify the users of the information warehouse themselves. Khan, therefore, does not teach or suggest determining an identity of the party to be provided the personal information as recited in claim 27.

Additionally, in Khan, the information warehouse is configured to gather, store, and organize information (abstract) and to make the entire web of relationships available (col. 2, lines 17-18). In contrast, the determination of whether a selected field of personal information can be provided to the first party recited in claim 27 may result in information not being provided to the party. By not providing information to the party, certain fields are excluded, making search results incomplete. Thus, making the entire web of relationships available in Khan actually teaches away from field-level control of personal information of a second party that can be provided to the first party. Therefore, claim 27 is allowable over Khan for at least the above reasons.

Specifically regarding the dependent claims, as a dependent claim incorporates by reference all the limitations of the claim from which it depends (*see* 35 U.S.C. § 112, ¶ 4), claims 28-34 are allowable for at least the same reasons as claims 27.

Claim 28 recites determining whether a selected field of personal information of the second party can be provided to the first party using a unique identifier of the second party. According to Khan, a particular ID associated with an individual is used to create links to other data items based on the individual's relationships (col. 9, lines 14-18). Once the particular ID of an individual is determined, the data items linked to that ID are freely available to the user (Figure 7a, Table 3, columns 9, line 5 to col. 11, line 34). While the selected field recited in claim 28 is associated with a party using a unique identifier, the unique identifier is further used to determine whether the field can be shared with the

other party. The unique identifier recited in claim 28 identifies both the personal information being sought and provides a mechanism for implementing field-level control of the personal information. Therefore, in Khan, Applicants fail to see a teaching to determine whether a selected field of personal information of a party can be provided to another party using a unique identifier of the party as recited in claim 28.

Claim 29 recites, “the engine is configured to determine whether the selected field of the personal information of the second party can be provided to the first party using a unique identifier of the first party.” As cited in the Office Action, the table described in Khan contains a unique relatee type and relatee ID used to define relationships without defining the subject (Figure 7c-1 and col. 10, lines 45-46). Khan teaches a table used to assign an ID and a LinKID to individuals (Figure 7a, Table 3). The LinKID and the ID described in Khan “allows users to retrieve information from the information base using search techniques” (abstract and col. 9, lines 3-18). The ID specifically identifies the individual (col. 10, lines 13-15). The LinKID is used to identify whether the individual is a business contact or family member of at least one other individual (col. 10, lines 20-22). Merely using the ID and LinKID fields to retrieve information about individuals within the database, as in Khan, is not analogous to using the unique identifier to determine whether to share selected fields of personal information with the party receiving the personal information. Therefore, Applicants fail to see how Khan teaches or suggests using a unique identifier to determine whether the selected field of information can be provided to a party as recited in claim 29.

New claim 35 includes limitations similar to those of claim 27, and is, therefore, believed to be allowable for at least the same reasons as claim 27. Claims 36-42 are allowable for at least the same reasons as claim 27.

New claim 43 includes limitations similar to those of claim 27, and is, therefore, believed to be allowable for at least the same reasons as claim 27. Claims 44-49 are allowable for at least the same reasons as claim 27.

### **35 U.S.C. §103(a) Rejections**

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Khan in view of U.S. Patent No. 6,487,557 to Nagatomo. As claim 12 has been cancelled, this 35 U.S.C. §103(a) rejection is moot. Applicants do not acquiesce to the §103(a) rejection for claim 12 and do not intend to create estoppel by cancelling claim 12.

Claims 13-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Khan in view of U.S. Patent No. 5,963,642 to Goldstein. As claims 13-14 have been cancelled, this 35 U.S.C. §103(a) rejection is moot. Applicants do not acquiesce to the §103(a) rejection for claims 13-14 and do not intend to create estoppel by cancelling claims 13-14.

### CONCLUSION

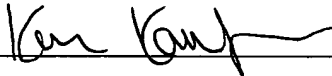
In view of the above remarks, the Applicants believe that these claims are in condition for allowance. The Examiner is respectfully requested to allow the pending claims in this application. The Examiner is invited to call Applicants' representative at the number below if the Examiner has any questions or if there are remaining outstanding issues.

Respectfully submitted,

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